



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,189	11/17/2000	James MacPherson	DT-3788	173

30377 7590 03/16/2004

DAVID TOREN, ESQ.
SIDLEY, AUSTIN, BROWN & WOOD, LLP
787 SEVENTH AVENUE
NEW YORK, NY 10019-6018

EXAMINER

GRAHAM, CLEMENT B

ART UNIT	PAPER NUMBER
----------	--------------

3628

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/716,189

Applicant(s)

MACPHERSON, JAMES

Examiner

Clement B Graham

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3628

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-45, are rejected under 35 U.S.C. 101 because the claimed invention is not supported by either a specific and substantial asserted utility or a well established utility. The claimed invention is noted not to be a computer program, data structure, a natural phenomenon, and a non-descriptive material per se. Furthermore, the claimed invention do not produce a useful, concrete and tangible result therefore they are nonstatutory. The claimed invention also is not a product for performing a process, nor it is a specific machine or manufacture. The claimed invention is not a specific tangible machine or process for facilitating a business transaction.

As to the technology requirement, note MPEP Section iV 2(b). Also note In Re Waldbaum, 173USPQ 430 (CCPA 1972) which teaches "useful arts" is synonymous with "technological arts". In re Musgrave, 167USPQ 280 (CCPA1970), In re Johnston, 183USPQ 172 (CCPA 1974), and In re Toma, 197USPQ 852 (CCPA 1978), all teach a technological requirements.

For a claim to be statutory under 35 USC 101 the following two conditions must be met:

- 1) In the claim, the practical application of an algorithm or idea result in a useful, concrete, tangible result, AND
- 2) The claim provides a limitation in the technological art that enables a useful, concrete, tangible result.

Art Unit: 3628

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or unobviousness.
5. Claims 1-45, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shkedy U.S. Patent 6, 236, 972 in view of Hawkins U.S. Patent 6, 247, 000.

As per claims 1-17, Shkedy discloses a method for processing mutual fund order messages, including purchase and redemption transactions, comprising the steps of receiving order messages from at least one of a plurality of designated Exchanges. ("i. e, buyers and sellers" see column 4 lines 15-65 and column 9 lines 10-15") and reformatting. (i. e, formats") the order messages. (see column 13 lines 40-50). Shkedy fails to explicitly teach transmitting the order messages to at least one of a plurality of Fund/Securities Clearing Agents for confirmation, clearing and settlement.

However Hawkins discloses an embodiment of the present invention, which operates in conjunction with a system and method for, among other things, direct broker to broker trading, automatically matches an investor's security order with an executing broker's confirmation and automatically generates and routes via a network, such as the Society

Art Unit: 3628

for Worldwide Interbank Financial Telecommunication (SWIFT) Financial Network, a settlement instruction to the investor's clearing agent.

By allowing securities participants to match orders to executions on trade date and by automatically generating pre-matched settlement instructions to clearing agents on trade date, the system increases the accuracy, reduces the cost, reduces the inherent financial risk, and increases the rate of settlement for all security participants and The primary component includes boxes for price type, dealing capacity, attribute, conditions, trade place, clearing agent, receiver of cash, and memo. (see column 7 lines 55-65 and column 8 lines 5-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Shkedy to include transmitting the order messages to at least one of a plurality of Fund/Securities Clearing Agents for confirmation, clearing and settlement taught by Hawkins in order to transmit an order message and matching the transaction financial automatically that are electronically traded among various user groups and matching securities traded among brokers whereby a clearing agent can perform settlement of the trade transaction.

As per claims 18-29, Shkedy discloses a method for processing mutual fund order messages, including purchase and redemption and buy and sell transactions, comprising the steps of receiving order messages at an Exchange from at least one Member Firm.(see column 4 lines 35-65).

Art Unit: 3628

Shkedy fails to explicitly teach transmitting the matched and executed order messages to at least one of a plurality of ordering Member Firms for confirmation and to at least one of a plurality of Funds/Securities Clearing Agents for clearing and settlement.

However Hawkins discloses an embodiment of the present invention, which operates in conjunction with a system and method for, among other things, direct broker to broker trading, automatically matches an investor's security order with an executing broker's confirmation and automatically generates and routes via a network, such as the Society for Worldwide Interbank Financial Telecommunication (SWIFT) Financial Network, a settlement instruction to the investor's clearing agent.

By allowing securities participants to match orders to executions on trade date and by automatically generating pre-matched settlement instructions to clearing agents on trade date, the system increases the accuracy, reduces the cost, reduces the inherent financial risk, and increases the rate of settlement for all security participants and The primary component includes boxes for price type, dealing capacity, attribute, conditions, trade place, clearing agent, receiver of cash, and memo. (see column 7 lines 55-65 and column 8 lines 5-45).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Shkedy to include transmitting the matched and executed order messages to at least one of a plurality of ordering Member Firms for confirmation and to at least one of a plurality of funds/Securities Clearing Agents for clearing and settlement taught by Hawkins in order to transmit an order message and matching the transaction financial automatically that are electronically

Art Unit: 3628

traded among various user groups and matching securities traded among brokers whereby a clearing agent can perform settlement of the trade transaction.

As per claims 30-45, Shkedy discloses a method for processing mutual fund order messages, including purchase and redemption transactions, comprising a server for receiving order messages from at least one of a plurality of designated Exchanges. ("i. e, buyers and sellers" see column 4 lines 15-65 and column 9 lines 10-15") and

reformatting. (i. e, formats") the order messages. (see column 13 lines 40-50).

Shkedy fails to explicitly teach transmitting the order messages to at least one of a plurality of Fund/Securities Clearing Agents for confirmation, clearing and settlement.

However Hawkins discloses an embodiment of the present invention, which operates in conjunction with a system and method for, among other things, direct broker to broker trading, automatically matches an investor's security order with an executing broker's confirmation and automatically generates and routes via a network, such as the Society for Worldwide Interbank Financial Telecommunication (SWIFT) Financial Network, a settlement instruction to the investor's clearing agent.

trade date, the system increases the accuracy, reduces the cost, reduces the inherent financial risk, and increases the rate of settlement for all security participants and The primary component includes boxes for price type, dealing capacity 227b, attribute conditions, trade place, clearing agent, receiver of cash, and memo. (see column 7 lines 55-65 and column 8 lines 5-45).

Art Unit: 3628

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Shkedy to include transmitting the order messages to at least one of a plurality of Fund/Securities Clearing Agents for confirmation, clearing and settlement taught by Hawkins in order to transmit an order message and matching the transaction financial automatically that are electronically traded among various user groups and matching securities traded among brokers whereby a clearing agent can perform settlement of the trade transaction.

Conclusion

6. The prior art of record and not relied upon is considered pertinent to Applicants disclosure.

Walker et al (US 6, 267, 292 Patent) teaches method and apparatus for funds and credit line transfer.

Walker et al (US 5, 949, 044 Patent) teaches method and apparatus for funds and credit line transfer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are for regular communications and 703-305-7687 for After Final communications.

Art Unit: 3628

- Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

CG

March 04, 2004

Tom
RECEIVED
MAR 11 2004
AU 3628